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SUITE 900  
SAN DIEGO CA 92101-8285

**COPY MAILED**  
**DEC 22 2008**

In re Application of	:	
Matos et al.	:	DECISION ON PETITION
Application No. 10/632,517	:	UNDER 37 CFR 1.78(a)(6)
Filed: July 31, 2003	:	
Atty Docket No. U1656-00007	:	
	:	

This is a decision on the PETITION TO ACCEPT AN UNINTENTIONALLY DELAYED CLAIM UNDER 35 U.S.C. §119(e) FOR THE BENEFIT OF A PRIOR-FILED PROVISIONAL APPLICATION, 37 C.F.R. 1.78(c) filed July 18, 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of priority to prior-filed provisional application No. 60/399,834 filed July 31, 2002. Receipt of the status inquiry filed September 26, 2008 is acknowledged. This decision is made in light of the request for continued examination (RCE) filed October 30, 2008.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR § 1.78(a)(5)(ii), and must be filed during the pendency of the nonprovisional application. In addition, the petition under 37 CFR § 1.78(a)(6) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i), of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii), and the date the

claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant application was filed after November 29, 2000. A review of the application as filed reveals that the claim for priority set forth on petition was not submitted on filing in the first sentence of the specification or in an application data sheet. The four and sixteen-month periods specified in 37 CFR § 1.78(a)(5)(ii) expired without the claim having been submitted. Thus, the instant petition is appropriate. The petition includes the required surcharge and the required statement of unintentional delay.

A reference to the prior-filed application was included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(5)(iii). This amendment was filed on April 14, 2008. (To avoid a determination that applicants have not fully complied with the rule, it is recommended that applicants insert their reference in the first sentence of the specification immediately following the title of the application, and not use a sub-header such as "CROSS-REFERENCE TO RELATED APPLICATIONS" prior to the reference).

Moreover, a final Office action was mailed in this application on July 10, 2008 (and an amendment under 37 C.F.R. §1.116 was filed in response on July 18, 2008). On October 30, 2008, applicants submitted a Request for Continued Examination (RCE) (with fee and submission). The RCE is accepted for consideration of this amendment after mailing of a final Office action.

Additionally, this pending nonprovisional application was filed on July 31, 2003, which is within twelve months of the filing date of provisional application No. 60/399,834, which was filed on July 31, 2002, and for which priority is claimed. A review of the prior filed provisional application confirms that the filing fee was paid.

Thus, the reference submitted April 14, 2008 is being accepted for purposes of satisfying the requirements of 37 CFR 1.78(a)(6).

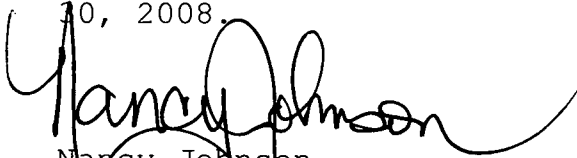
All of the above requirements having been satisfied, the late claim for benefit of priority to the prior-filed application under 35 U.S.C. § 119(e) is accepted as being unintentionally delayed.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR § 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §§119(e) and 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed application, accompanies this decision on petition.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3219. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center Art Unit 2626 for consideration by the examiner of i) the claim for benefit of priority under 35 U.S.C. § 119(e) of the prior-filed application as set forth in the amendment filed April 14, 2008, ii) the amendment directed to the claims filed July 18, 2008 in response to the final Office action mailed July 10, 2008, and iii) the request for continued examination (RCE) filed October 10, 2008.

  
Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions

**ATTACHMENT:** Corrected Filing Receipt



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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	TOT CLAIMS	IND CLAIMS
10/632,517	07/31/2003	2626	639	U1656-00007	41	2

CONFIRMATION NO. 4344

CORRECTED FILING RECEIPT



OC000000033734307

53897  
DUANE MORRIS LLP - San Diego  
101 WEST BROADWAY  
SUITE 900  
SAN DIEGO, CA 92101-8285

Date Mailed: 12/22/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Paulo Matos, Residence Not Provided;  
Brian O'Connor, Residence Not Provided;

**Power of Attorney:** The patent practitioners associated with Customer Number 53897

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/399,834 07/31/2002

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 10/30/2003

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/632,517**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**\*\* SMALL ENTITY \*\***

**Title**

System and method for enabling automated dialogs

**Preliminary Class**

704

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**

**Title 35, United States Code, Section 184**

**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

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This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

#### **NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).